

REMARKS

Applicants timely submit this Request for Reconsideration to the Examiner's Office Action of June 19, 2008 that extends the period of response through September 19, 2008. The Office Action has been carefully reviewed and the following remarks are made in response thereto. Claims 5 and 22 were amended. Applicants submit that no prohibited new matter was introduced. In view of the amendment and following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

I. Summary of the Office Action

1. Upon entry of the attached amendment, claims 1, 2, 5, 6, and 21-26 will be pending.

2. Claims 1, 2 and 21-26 are rejected under 35 USC § 102(b) as allegedly anticipated by Jaetsch *et al.* (U.S. Patent Application Publication No. 2001/0027217) as evidenced by Lambuth *et al.* (U.S. Patent No. 3,909,470).

3. Claims 1, 2, 5, 6, and 21-26 are rejected under 35 USC § 103(a) as allegedly obvious over Buschhaus *et al.* (International Application Publication No. WO 98/18328) in view of Isato *et al.* (JP Patent No. JP 8039511 and Sun *et al.* (U.S. Patent Application Publication No. 2003/0194419).

4. No claims were allowed.

II. Response to the Office Action

1. Claim Rejections under 35 U.S.C. §102(b)

A. Jaetsch *et al.* evidenced by Lambuth *et al.*

Claims 1, 2 and 21-26 are rejected under 35 USC § 102(b) as allegedly anticipated by Jaetsch *et al.* (U.S. Patent Application No. 2001/0027217) as evidenced by Lambuth *et al.* (U.S. Patent No. 3,909,470). Applicants respectfully traverse this rejection.

The Examiner alleges that Jaetsch *et al.* disclose bifenthrin and resin-containing adhesive (i.e. glue) for wooden material or wood composites. Further, the Examiner alleges that Jaetsch *et al.* disclose various additives included in the formulations of the invention and wheat flour is a common additives conventionally used in adhesive

formulations as evidenced by Lambuth *et al.* The Examiner also alleges that Jaetsch *et al.* disclose a variety of resins useful in the invention including melamine-urea copolymer resin, phenol resin, resorcinol resin and isocyanate resin and examples of wood products including, *inter alia*, plywood, LVL and particle boards.

Jaetsch *et al.*, however, does not teach each and every element of the pending claims. Jaetsch *et al.* discloses formulations for production of wooden material or wood composites containing monophenolic compounds and other anti-insect, anti-basidiomycetes, anti-termite and anti-fungal agents. (See Abstract, [0009] and [0011] of Jaetsch *et al.*) Although bifenthrin is exemplified as an anti-insect and anti-termite agents in the disclosed formulations ([0027] of Jaetsch *et al.*), Jaetsch *et al.* does not contemplate, suggest or teach that bifenthrin is particulated or bifenthrin has a mean particle size of 1-10 μm . As the Examiner acknowledges on page 3 of the Office Action, Jaetsch *et al.* is completely silent with regard to the particle size of bifenthrin in the adhesive formulation. The formulations of the Examples of Jaetsch *et al.*, for example, include 3% imidacloprid in 62% solvent ([0038]: Example of execution 1; [0050]: Example of comparison 1), 20% thiabendazole in 80% solvent ([0052]: Example of execution 2; [0055]: Example of comparison 2), 25% chlorpyrifos in 35% solvent ([0063]: Example of execution 3; [0066]: Example of comparison 3), 30% chlorpyrifos in 70% solvent ([0071]: Example of comparison 4; [0075]: Example of execution 4), 5% bifenthrin in 90% solvent ([0078]: Example of execution 5; [0081]: Example of comparison 5). Example of execution 5 and Example of comparison 5 disclose that bifenthrin is applied as the mixing solution in treating the backside of plywood. ([0078] and [0081] of Jaetsch *et al.*). In each example, including the bifenthrin of Example 5, the biocide is dissolved in a solvent and is not particulate bifenthrin with a mean particle size of 1-10 μm . Accordingly, Applicants respectfully submit that the formulations of Jaetsch *et al.*, which comprise dissolved, anti-insect, anti-basidiomycetes, anti-termite and anti-fungal agents, do not anticipate the pending claims.

The Examiner alleges that it is well within the ability of one skilled in the art to optimize the particle size of the bifenthrin active ingredient to provide maximal anti-insecticide effect. Further, the Examiner alleges that because the specification does not disclose any methods to obtain bifenthrin in the specified sizes and the specification discloses commercially-available bifenthrin formulations such as Bistar™, it is reasonable to expect that commercially-available sources of bifenthrin are used in Jaetsch *et al.* Applicants

respectfully submit that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (MPEP §2131, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Therefore, the Examiner’s allegations regarding optimization of particle size are irrelevant, under 35 U.S.C. § 102(b), because Jaetsch *et al.* does not teach a glue comprising particulate bifenthrin.

The Examiner alleges that although Jaetsch *et al.* are silent as to the type of flour included in the formulations, wheat flour is a common additive conventionally used in adhesive formulations as evidenced by Lambuth *et al.* and it is reasonable to expect that the flour of Jaetsch *et al.* is wheat flour. Applicants respectfully traverse the rejection of claim 26.

Although claim 26 is allegedly rejected as anticipated, under 35 U.S.C. § 102, the Examiner relies on two references. MPEP § 2131.01 states that “only one reference should be used in making a rejection under 35 U.S.C. § 102. However, 35 U.S.C. § 102 rejection over multiple references [have] been held to be proper when the extra references are cited to: (A) prove the primary reference contains an “enabled disclosure;” (B) explain the meaning of a term used in the primary reference: or (C) show that a characteristic not disclosed in the reference is inherent.” Lambuth *et al.* falls into none of these exceptions. Specifically, Lambuth *et al.* **does not** (A) prove the primary reference contains an “enabled disclosure;” (B) explain the meaning of a term used in the primary reference: or (C) show that a characteristic not disclosed in the reference is inherent. Accordingly, the Examiner has failed to establish *prima facie* anticipation.

Jaetsch *et al.* does not recite the limitation of a mean particle size of bifenthrin of claims 1, 2, and 21-26. Jaetsch *et al.* neither anticipates nor suggests the glue of claims 1, 2 and 21-26. Accordingly, Applicants respectfully request withdrawal of this rejection.

2. Claim Rejections under 35 U.S.C. §103(a)

A. Buschhaus *et al.* in view of Isato *et al.* and Sun *et al.*

Claims 1, 2, 5, 6, and 21-26 are rejected under 35 USC § 103(a) as allegedly obvious over Buschhaus *et al.* (International Application Publication No. WO 98/18328) in view of Isato *et al.* (JP Patent No. JP 8039511 and Sun *et al.* (U.S. Patent Application Publication No. 2003/0194419). The Examiner alleges that Buschhaus *et al.* disclose

insecticide and resin-containing glues and adhesives for plywood and timber materials and that the adhesives also contain other additives such as flour and fungicides. According to the Examiner, Isato *et al.* disclose bifenthrin-containing adhesives for use with, *inter alia*, wood, plywood, laminated wood and other wood products and that the adhesives also contain additives including wheat flour. Therefore, the Examiner alleges that it would have been obvious to one of skill in the art to substitute one known insecticide for another in the formulation of Buschhaus *et al.* Further, the Examiner alleges that Sun *et al.* disclose pesticidal matrices wherein the insecticides have a particle size of less than 10 μm and a preferable particle size of 0.1-5 μm . Allegedly, the teaching of Sun *et al.* provides sufficient rationale for one skilled in the art to utilize bifenthrin of the specified particle size in the formulations of Buschhaus *et al.* or Isato *et al.* The Examiner also alleges that Buschhaus *et al.* teach the use of insecticide concentrations from 30-104 g ai/m³ and teach the use of phenol/formaldehyde resins as well as urea/resorcinol resins. Therefore, according to the Examiner, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use bifenthrin of the claimed particle size in the formulation of Buschhaus *et al.* to achieve the desired insecticidal effects. Applicants respectfully traverse this rejection.

Buschhaus *et al.* teach mixtures of binders or adhesives which can be used in the manufacture of plywood and timber materials with the compounds of the general formula (I) specified in Buschhaus *et al.* (page 1, lines 21-25 of Buschhaus *et al.*). Further, Buschhaus *et al.* discloses that glues and adhesives are used as binders and biocides such as insecticide and fungicide can be incorporated into the bonding agent. (page 8, lines 7-19 of Buschhaus *et al.*) As the Examiner admits in the Office Action (page 5), Buschhaus *et al.* does not disclose bifenthrin as an insecticide that can be mixed with binders or adhesives and Buschhaus *et al.* does not disclose any particle sizes of insecticide or fungicide in the mixtures of binder or adhesives. Therefore, Buschhaus *et al.* do not contemplate, suggest or teach particulate bifenthrin with a mean particle size of 1-10 μm .

The Examiner alleges that it is *prima facie* obvious to substitute one known insecticide (i.e. bifenthrin) for another in the formulation of Buschhaus *et al.*, because Isato *et al.* teach bifenthrin-containing adhesives including other additives such as wheat flour for use with wood. Applicants respectfully disagree.

Isato *et al.* does not disclose or suggest particulate bifenthrin or that the disclosed bifenthrin has a mean particle size of 1-10 μm . Isato *et al.* is totally silent as to the particle sizes of pyrethroid, or particle sizes of bifenthrin to prevent termites. Further, Example of Isato *et al.* demonstrates that the adhesives are prepared as “the pasty liquid” with a resin emulsion, curing agent, and an insecticide. ([0009] of Isato *et al.*, English translation) Therefore, substitution of insecticide of Buschhaus *et al.* with bifenthrin taught by Isato *et al.* does not provide the particulated bifenthrin with a mean particle size between 1-10 μm . The Examiner’s combination of Buschhaus *et al.* and Isato *et al.* do not teach every element of the pending claims, nor do they render the claimed invention obvious.

Sun *et al.* teach a process for the preparation of a coated pesticidal matrix comprising a pesticidal agent, a pH-dependent polymer and water, in which the pH is below the solubilization pH of the polymer. Sun *et al.* does not disclose bifenthrin as a suitable pesticidal agent. Pesticidal agents suitable for use in the disclosed compositions of Sun *et al.*, when in solid form, have a particle size **prior to coating** of less than 10 μm , preferably, about 0.1 μm to 5 μm . ([0021] of Sun *et al.*) Sun *et al.* teach away from the claimed invention, because Applicants disclose that “the repellent effect of bifenthrin as a Glue line additive is significantly influenced by particle size” and “[W]hen veneer based composites using veneer thickness of 3.2 mm or more it was found that at equal loadings, formulations with bigger particle size would protect better the external veneer of the product.” ([0021] and Table 3 of Application).

Accordingly, Applicants respectfully submit that the Examiner has not established a reason or motivation for modifying the pesticidal matrix of Sun *et al.* to produce a mean particle size of 1-10 μm of bifenthrin, as claimed.

Applicants respectfully submit that the Examiner’s combination of references do not teach every element of the pending claims, nor do they render the claimed invention obvious. Accordingly, withdrawal of the rejection is respectfully requested.

III. Conclusion.

Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 13-3250, Reference No. 38184.04013US. This paragraph is intended to be an **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with C.F.R. § 1.136(a)(3).

Respectfully submitted,

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